



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/871,004	06/06/97	NEUMANN	NEU-101

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19M1/0923

EXAMINER  
LAVINDER, J

ART UNIT	PAPER NUMBER
1921	8

DATE MAILED: 09/23/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/871,004**

Applicant(s)  
**Neumann**

Examiner  
**Jack W. Lavinder**

Group Art Unit  
**1921**



☒ Responsive to communication(s) filed on Aug 3, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Information Disclosure Statement***

1. The information disclosure statement filed 8-3-98 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.
2. The information disclosure statement filed 8-3-98 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

***Election/Restriction***

3. Claims 11-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 7.

***Claim Rejections - 35 USC § 112***

4. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility.

The claims are directed to a method of exterminating insects by directing a killing solution comprising an aqueous formulation containing capsicum into infested areas of the structure and contacting the insects. The well established utility of using capsicum in treating an ingested area

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is that the capsicum repels insects and creates a synergistic affect when used with an existing insecticide. The patent to Hainrihar, '597, in column 1, lines 39-47, states

“The following examples show that capsaicinoids are not toxic to insects, when used alone, and the observations of the inventors in this regard is similar to the known effect of capsaicinoids on humans...”

Therefore, the prior art has established that the use of capsaicinoids, which encompasses capsicum, is nontoxic to insects. Thus, the applicant's claim that their invention of exterminating/killing insects with an aqueous solution containing capsicum is not credible unless the applicant can supply some form of unbiased scientific evidence which disputes the assertion set out in the prior art.

Claims 1-10 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

### ***Response to Amendment***

5. The declaration under 37 CFR 1.132 filed 8-3-98 is insufficient to overcome the rejection of claims 1-10 based upon the 101 and 112 rejections as set forth in the last Office action because: the declaration is merely an opinion by the applicant that capsicum in his solution kills termites. The applicant states that they experimented with one or two or three different types of insects and

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the effects of their insecticide on them. The experiments are merely done once or twice on the certain insect and conclude that it kills the insect. In order for the results of these experiments to have any credibility, a statistical analysis needs to be done to determine how many of these experiments must be performed on a specific insect to determine factually that the solution is actually killing the insect. One or two experiments is not enough evidence to sway the examiner's opinion that the capsicum is non-toxic to insects. Also, a third party should perform these experiments in order for their results to be considered credible and unbiased. The third party should be an accredited lab or person to give credibility to the results.

6. Applicant's arguments filed 8-3-98 have been fully considered but they are not persuasive.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Lavinder whose telephone number is (703) 306-3470.



**JACK W. LAVINDER**  
**PRIMARY EXAMINER**

September 21, 1998